

## **REMARKS/ARGUMENTS**

The office action dated March 4, 2011 has been received and carefully considered. By this amendment, claims 25, 30 and 34 are amended. With these amendments, no new matter is added. After entry of this Amendment, claims 25-34 will be pending. In view of these amendments and the following remarks, Applicant respectfully requests reconsideration.

### **35 U.S.C. 112 Rejection**

The Office rejected claim 30 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Office argues that the claimed "drill bit according to claim 25" is not recited in claim 25. In response, Applicant amends claim 30 to recite "the cutting tip according to claim 25", and thereby believes the rejection to be overcome.

The Office rejected claim 34 under 35 U.S.C. 112, second paragraph, as also being indefinite. Specifically, the Office argues that the claimed "drill bit of claim 25" is indefinite because claim 25 is directed to a method. In response, Applicant amends claim 34 to recite "The method of claim 25", and thereby believes the rejection to be overcome.

### **35 U.S.C. 102 (Shaw)**

The Office rejected claims 25, 26, 28, 30 and 32 under 35 U.S.C. 102(b) as being anticipated by Shaw (US 5261818). Applicant respectfully traverses those rejections.

Independent claim 25 requires the step of providing a shaft having a distal end with a second opening extending from the distal end through a beveled portion of a cutting tip, and Shaw fails to teach these limitations. Rather, Shaw teaches a drill bit 10 having outlets 22 that are proximal to beveled tip 14 (shown in Fig. 1 of Shaw), which clearly do not extend from the distal end of the tip 14 through a beveled portion of the tip 14 (see abstract; C2/L32-34; and Figs. 1-2).

Thus, Shaw fails to teach, suggest, or motivate all of the claimed limitations of claim 25, and Applicant respectfully requests the above rejection to be withdrawn. The rejections of claims 26, 28, 30 and 32 should also be withdrawn at least due in part to their dependency upon claim 25.

### **35 U.S.C. 103 (Shaw)**

The Office rejected claims 27 and 31 as being obvious over Shaw (US 5261818). Applicant respectfully traverses those rejections.

Claim 27 and 31 also require the step of providing a shaft having a distal end with a second opening extending from the distal end through a portion of a cutting tip, which Shaw fails to teach, suggest or motivate. As discussed above, Shaw contemplates that the openings are disposed proximal to tip 14, and the openings clearly do not extend from the distal end of the tip through a beveled portion of the tip 14 (see abstract; C2/L32-34; and Figs. 1-2). Thus, claims 27 and 31 are allowable by virtue of their dependency on claim 25, and Applicant believes the above rejections to be overcome.

### **35 U.S.C. 103 (Shaw in view of Pshenichny)**

The Office rejected claims 29, 33 and 34 as being obvious over Shaw (US 5261818) in view of Pshenichny (US 3750667). As discussed above, Shaw fails to teach, suggest or motivate all of the claimed limitations of claim 25 from which claims 29, 33 and 34 depend, and the addition of Pshenichny adds little to the analysis. Thus, for the reasons discussed above, the combination of Shaw and Pshenichny fails to teach, suggest, or motivate all of the claimed limitations of each of claims 29, 33 and 34.

**Request For Allowance**

Claims 25-34 are pending in this application. The Applicant requests allowance of all pending claims.

Respectfully submitted,  
Fish & Associates, PC

Date: June 2, 2011

By: /Ryan Dean/  
Ryan S. Dean  
Reg. No. 61570

Fish & Associates, PC  
2603 Main Street, Suite 1000  
Irvine, CA 92614-4271  
Telephone (949) 943-8300  
Fax (949) 943-8358